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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,521	02/20/2004	Minoru Goda	7985/7	7165

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Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

EXAMINER

WARD, JESSICA LEE

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,521

Applicant(s)

GODA, MINORU

Examiner

Jessica L. Ward

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Komatsu (WO 03/024676, refer to US 2004/0231478 for translation).

The reference teaches making a 3D embroidery product by providing layers of fabric comprising a base layer (1), a top layer (5) and an intermediate layer (5) of a thickness (Figure 4; section 0022]), embroidering a pattern through the layers of fabric with thread (2), cutting the intermediary layer at a height to separate the top and base layers (abstract; Figures 1-2; section [0024]), and removing the remaining intermediary layer from at least one of the top and base layers (section [0024]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu as applied to claim 1 above, and further in view of Tajima et al. (US 6263817).

Art Unit: 1791

As to claim 2, it would have been obvious to include a flat pattern in the 3D embroidery product of Komatsu because such is known in the art, as taught by Tajima, for providing desirable visual effects (column 10, lines 37-42).

As to claim 10, one reading Komatsu would have readily appreciated that the reference is not concerned with a particular technique for removing the intermediary layer. Tajima teaches it being known in the art to use a soluble material as an auxiliary layer, which supports and protects the base layer during embroidering, and to remove the auxiliary layer by dissolving it in a solvent so that only the threads and base layer are left behind (abstract; column 7, lines 43-49 and 63-65; column 10, lines 49-60; column 11, lines 25-30; column 12, lines 9-45). Therefore, it would have been obvious to use a soluble material for the intermediary layer of Komatsu because such is known in the art, as taught by Tajima, where only the predictable results of quickly and easily removing the intermediary layer would have been achieved.

5. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu as applied to claim 1 above, and further in view of Jalowsky (US 4517910).

As to claims 3-4, it is unclear if Komatsu teaches bonding a thermal fusible film to at least one of the base and top layers prior to cutting the intermediary layer. Jalowsky teaches it being known in the art to bond a thermal fusible film to a base layer prior to a cutting step that removes unwanted portions of a 3D embroidery product because the film allows the product to be bonded to an article (abstract; column 2, line 67 – column 3, line 10; column 3, lines 40-67; column 4, lines 11-23). Therefore, it would have been obvious to bond a thermal fusible film to the base layer of Komatsu prior to cutting because such is known in the art, as taught by Jalowsky, and the film allows the 3D embroidery product to be bonded to an article.

Art Unit: 1791

As to claims 5-6, selection of a particular type of thermal fusible film would have been within purview of one having ordinary skill in the art depending on the desired characteristics of the film.

6. Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu as applied to claim 1 above, and further in view of Fortuna (US 6718895).

As to claim 7, selection of a type of thread would have been within purview of one having ordinary skill in the art depending on the desired characteristics of the thread and the 3D embroidery product. However, it would have been obvious to use a type of thread claimed by Applicant because such is known in the art for being strong thread, as taught by Fortuna (column 4, lines 55-66).

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu as applied to claim 1 above, and further in view of JP 2000-64183.

As to claim 8, selection of a type of thread would have been within purview of one having ordinary skill in the art depending on the desired characteristics of the thread and the 3D embroidery product. However, it would have been obvious to use a type of thread claimed by Applicant because such is known in the art, as taught by JP 2000-64183 (abstract).

Response to Arguments

8. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica L. Ward whose telephone number is 571-272-1223. The examiner can normally be reached on Mon-Fri between 9AM and 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica L. Ward
Primary Examiner
Division 1791



JESSICA WARD
PRIMARY EXAMINER